REMARKS

I. Status of the Claims

Claims 1-37, 39-57, and 59-79 are pending in this application. Claims 1-36, 40, 42, 44-46, 50-57, 59, 64, and 65 were previously withdrawn pursuant to a Restriction Requirement issued on February 22, 2002, as being directed to the non-elected subject matter. Claims 37, 39, 41, 43, 47-49, 60-63, and 66-77 are withdrawn pursuant to an Election Requirement issued on March 23, 2004, as being directed to non-elected species. Therefore, claims 78 and 79 are currently subject to examination.

If the elected species is found allowable, Applicants expect the Examiner to continue to examine the full scope of the elected subject matter to the extent necessary to determine the patentability thereof, i.e., extending the search to a reasonable number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

In the present Amendment, claims 78 and 79 have been amended. Claim 78 has been amended to correct a clear error. Claim 79 has been amended to correct an informality. Applicants have not introduced any new matter by the amendments, nor are any estoppels intended thereby. Further, the amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner.

II. Rejection under § 112, Second Paragraph

The Examiner rejected claim 78 under 35 U.S.C. § 112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Office Action, page 3. Specifically, the

Examiner states that "Claim 78 recites the limitation 'said at last one compound'" that lacks antecedent basis. *Id.*

Applicants amended claim 78 to correct this clear error. Therefore, Applicants respectfully request this rejection be withdrawn.

III. Rejection under § 102(b)

The Examiner rejected claims 78 and 79 under 35 U.S.C. § 102(b) as being anticipated by "Drizen et al US Patent 5,897,880." Office Action, page 3. However, the Examiner's arguments in support of this rejection rely on Riordan (U.S. Patent No. 5,866,142). *See id.* For example, the Examiner alleges that "Riordan discloses compositions comprising . . ." *Id.* (emphasis added). Because the Examiner cites Riordan (U.S. Patent No. 5,866,142) in the PTO-892 form, and because U.S. Patent No. 5,897,880 relates to topical drug preparations, which are not relevant for this case, Applicants reasonably believe that the Examiner has made an error in citing Drizen et al. (U.S. Patent No. 5,897,880) for this rejection. Applicants respectfully request clarification of record.

To be fully responsive, Applications submit the following remarks in response to the Examiner's allegations based on the disclosure of Riordan for this rejection.

The Examiner alleges that "Riordan discloses compositions comprising N-acetyl-D-glucosamine and hyaluronic acid" "(see abstract; col. 7, lines 20-55; claims 13, 20-21)" and "[h]yaluronic acid which is a aminosaccharide comprising glucosamine and gluc[ur]onic acid meets the instant component of a different aminosugar that is different from glucosamine and comprise[s] at least one C5-C7 saccharides unit with at least one

amino group." Office Action, pages 3-4. The Examiner further alleges that "the amounts of aminosaccharides taught by Riordan overlaps with those taught in the instant specification." *Id.*, at page 4. Therefore, the Examiner concludes that Riordan's composition inherently posses the ability "to protect at least one keratinous fiber against extrinsic damage." *Id.* Applicants respectfully disagree for at least the following reason.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added). Further, a rejection under § 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972) (emphasis added). The identical invention must be described in as complete detail as is contained in, and must be arranged as required by, the claim. M.P.E.P. § 2131.

The Examiner has failed to establish that each and every element in claims 78 and 79 of the present invention is either expressly or inherently described in Riordan. Specifically, Riordan does not expressly or inherently teach "the at least one glucosamine" as cited in Claim 78 of the present invention (for example, the at least one glucosamine as cited in Claim 78 can be glucosamine HCl as used in Example 2 of the present invention. Specification, page 25, lines 4-5). Instead, Riordan merely teaches that its composition comprises, among other ingredients, N-acetyl-D-glucosamine. *See* Riordan, col. 7, lines 16-44. N-acetyl-D-glucosamine is different from the at least one glucosamine claimed in Claim 78 of the present invention.

In addition, Riordan does not expressly or inherently teach that the "at least one additional sugar [is] different from said at least one compound comprising at least one C_5 to C_7 saccharide unit substituted with at least one amino group and derivatives thereof, [and] said at least one additional sugar is unsubstituted" as recited in Claim 79 of the present invention. (Emphasis added). Instead, Riordan merely teaches that its composition comprises, among other ingredients, the sodium salt of hyaluronic acid. *Id.* Hyaluronic acid is defined as "the natural mucopolysaccharide formed by bonding N-acetyl-D-glucosamine with glucuronic acid." INTERNATIONAL COSMETIC INGREDIENT DICTIONARY AND HANDBOOK, 9th ed., 2002, page 741. As N-acetyl-D-glucosamine is a substituted sugar, it is different from the at least one additional sugar as claimed in claim 79 of the present invention.

Therefore, as Riordan fails to teach each and every element of claims 78 and 79, this rejection is improper. Accordingly, Applications respectfully request this rejection be withdrawn.

IV. Conclusion

In view of the foregoing remarks and amendments, Applicants respectfully request reconsideration and reexamination of this application, and the timely allowance of the rejected claims.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call the undersigned at (202) 408-4218.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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